

REMARKS

Claims 1-7 are pending in this application. By this Amendment, the specification is amended. No new matter is added by any of these amendments.

Applicants gratefully acknowledge that claims 2, 3 and 7 contain allowable subject matter. However, Applicants assert that all of claims 1 and 4-6 are allowable for the reasons discussed below.

Reconsideration based on the following remarks is respectfully requested.

I. Claims 1-7 Satisfy Obviousness-Type Double Patenting Requirements

The Office Action rejects claims 1-7 under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1, 2 and 5-7, respectively, of co-pending application 09/976,142, issued as U.S. Patent 6,760,097 (corresponding to Docket 110859), in view of U.S. Patent 4,554,587 to Ooi *et al.* (hereinafter “Ooi”).

A Terminal Disclaimer in compliance with 37 CFR §1.321(c) is filed herewith to obviate the obviousness-type double patenting rejection. Withdrawal of the double patenting rejection is respectfully requested.

II. Claims 1 and 4-6 Define Patentable Subject Matter

The Office Action rejects claim 1 under 35 U.S.C. §103(a) over, allegedly, “Applicant’s own admission of prior art” (hereinafter “AAPA”) in view of Ooi; and rejects claims 4-6 under 35 U.S.C. §103(a) over the alleged “AAPA” and Ooi and further in view of U.S. Patent 3,988,068 to Sprague. These rejections are respectfully traversed.

The Office Action asserts that the alleged “AAPA” teaches a lens evaluation apparatus including the features of Applicants’ claim 1 except for the image sensor having a light adjuster, but that Ooi compensates for this deficiency by teaching an image sensor with a light adjuster. However, Applicants submit that the specification discloses “related art”

rather than “prior art” in the background section. Applicants respectfully assert that use of their own specification for rejecting the claims based on teaching selected features therein represents a direct form of impermissible hindsight reasoning. Moreover, as admitted in the Office Action, the alleged “AAPA” does not teach or suggest a light adjuster for adjusting an amount of light incident on the image sensor, as recited in claim 1.

Ooi does not compensate for the deficiencies of the alleged “AAPA.” Instead, Ooi discloses an image pickup apparatus. In particular, Ooi teaches an image pickup tube 10 in a video camera, a diaphragm mechanism 14 and an electrochromic element 16 that serves as a filter between the tube 10 and a lens 12. Ooi further teaches an aperture control circuit 40 to control the diaphragm mechanism 14 (col. 2, line 60 – col. 3, line 18, col. 4, lines 3-20 and Fig. 1 of Ooi).

Also, Sprague does not compensate for the deficiencies of the alleged “AAPA” and Ooi outlined above for claim 1. Nor does Sprague teach, disclose or suggest the additional features recited in claims 4-6, particularly a distortion aberration calculator for calculating a distortion aberration of the projected image, as recited in claim 4. Instead, Sprague discloses an apparatus for detecting scratches, chips and other cosmetic defects in an ophthalmic lens 10. In particular, Sprague teaches a scanning system with a laser 11 with scanning mirror 18 and a lens 16 to produce and focus a beam of light 14 onto a point 17 on the lens 10 (col. 3, lines 44-64 and Fig. 1 of Sprague). By teaching a system directed to damage-induced defects on a lens surface, rather than topological deviations such as an aberration, Sprague teaches away from Applicants’ claimed features.

Further, there is no motivation to combine features related to the relative luminescence testing apparatus of the alleged “AAPA” with the video pickup tube of Ooi or the point defect detector of Sprague, nor has the Office Action established sufficient motivation for a *prima facie* case of obviousness.

Even assuming that motivation to combine the applied references is established, the combination fails to teach or suggest Applicants' claimed features.

A *prima facie* case of obviousness for a §103 rejection requires satisfaction of three basic criteria: there must be some suggestion or motivation either in the references or knowledge generally available to modify the references or combine reference teachings, a reasonable expectation of success, and the references must teach or suggest all the claim limitations (MPEP §706.02(j)). Applicants assert that the Office Action fails to satisfy these requirements with the alleged "AAPA", Ooi and Sprague.

For at least these reasons, Applicants respectfully assert that the independent claim is patentable over the applied references. The dependent claims are likewise patentable over the applied references for at least the reasons discussed, as well as for the additional features they recite. Consequently, all the claims are in condition for allowance. Thus, Applicants respectfully request that the rejections under 35 U.S.C. §103 be withdrawn.

III. Conclusion

In view of the foregoing amendments and remarks, Applicants respectfully submit that this application is in condition for allowance. Favorable reconsideration and prompt allowance are earnestly solicited.

Should the Examiner believe that anything further is desirable in order to place this application in even better condition for allowance, the Examiner is invited to contact Applicants' undersigned representative at the telephone number listed below.

Respectfully submitted,



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Attachment:

Terminal Disclaimer under 37 CFR §1.321

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